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In re Application of  
LAWLER *et al*  
U.S. Application No.: 10/574,385  
PCT No.: PCT/US2004/032609  
Int. Filing Date: 01 October 2004  
Priority Date: 03 October 2003  
Attorney Docket No.: 074408-9005-00  
For: MEASURING DEVICE, SUCH AS A  
SCALE OR MEDICAL SCALE

**DECISION**

This decision is in response to applicants' "Petition Under 37 C.F.R. § 1.47(a)" filed 24 July 2007.

**BACKGROUND**

On 26 February 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions available.

On 24 July 2007, applicants filed a response which was accompanied by, *inter alia*, a petition under 37 CFR 1.47(a); a declaration signed by two of the three joint inventors; a declaration by Sharon A. Johnson; a \$130.00 surcharge fee; a petition fee of \$200.00; a three-month extension and fee; and exhibits A - E.

**DISCUSSION**

In response to the Form PCT/DO/EO/905, applicants filed the petition under 37 CFR 1.47(a) claiming that Theron Kotze cannot be located.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Applicants completed items (1), (3) and (4) in the subject petition.

Regarding item (2), the 37 CFR 1.47(a) applicant included a declaration by

Sharon A. Johnson who stated that papers for the above-captioned application were forwarded to Mr. Kotze's last known address but returned as undeliverable by the USPS. Ms. Johnson then attempted to contact Mr. Kotze via email twice but the email were both returned as undelivered. Documentary evidence was provided to support Ms. Johnson's statement of facts as required. Applicants did not make any other attempts to locate and contact the nonsigning inventor.

This is not sufficient to meet item (2) of 37 CFR 1.47(a).

Applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In this case, petitioners have not made any attempt to locate Mr. Kotze using the internet and telephone directory to search for his address and/or telephone number. Applicants should also contact his former employer and former co-workers to determine if they have any information on the whereabouts of the nonsigning inventor. These efforts are not extraordinary and are required to meet the 'diligent effort' standard needed to satisfy item (2) above.

For the reasons discussed above, item (2) is not yet satisfied.

### CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

10/574,385

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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